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APPLICATION NO.	09/902,555	FILING DATE	07/10/2001	FIRST NAMED INVENTOR	Pierre Hirsbrunner	ATTORNEY DOCKET NO.	81358-200	CONFIRMATION NO.	7190
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EXAMINER

KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,555

Applicant(s)

HIRSBRUNNER ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-30 is/are allowed.
- 6) ☒ Claim(s) 1-5, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 6 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

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This action is in response to applicants' amendment of 23 May 2003. The 35 USC 102 rejections are withdrawn and the 35 USC 112 rejections is withdrawn due to the amendments to the claims. The objection to the specification is withdrawn due to the amendment to the specification. The 35 USC 103 rejection over JP 51-126,986 is withdrawn due to the amendment to the claims. Applicant's arguments with respect to the remaining rejection have been fully considered but they are not persuasive.

EP 89,109 has been considered with respect to the discussion of this reference given in the specification.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown.

This reference teaches a substrate treating solution for imparting hydrophobicity to the substrate comprising an aqueous solution of an alkali metal silicate and an alkali metal alkyl silicate. Run numbers 7-9 teach aqueous compositions containing 1.25 wt% sodium silicate and 0.25 wt% sodium methyl silicate; 2.5 wt% sodium silicate and 0.5 wt% sodium methyl silicate and 5 wt% sodium silicate and 1 wt% sodium methyl silicate. The composition falls within the claimed range. Column 5, lines 40-55 teach the composition contains 0.1-10 wt% silicate and 0.1-30 wt% silicate. These amounts overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA

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1960). Since the weight percentages overlap, one of ordinary skill in the art would be expected to expect the molar ratios to also overlap, absent any showing to the contrary. The reference suggests the claimed composition. Since the claimed and taught composition overlap, one of ordinary skill in the art would expect the taught composition to have the claimed property of claim 19 in the overlapping range and to have a composition that overlaps that of claim 18.

Applicants' arguments are that the composition of Brown is not used as an agricultural soil treating solution. The intended use of composition is not patentably significant. *In re Albertson* 141 USPQ 730 (CCPA 1964); *In re Heck* 114 USPQ 161 (CCPA 1957). The rejection is maintained.

Claims 6 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 20-30 are allowed.

There is no teaching or suggestion in the cited art of record of the claimed aqueous solution of an alkali metal silicate and an alkali metal alkyl siliconate which further comprising a coloring agent and/or an agrochemical principle.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (703) 308-3817. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (703) 308-3823.

The fax number for Amendments filed under 37 CFR 1.116 or After Final communications is (703) 872-9311. The fax number for all other official communications is (703) 872-9310.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661 or (703) 308-0662.

cmk
June 27, 2003


C. Melissa Koslow
Primary Examiner
Tech. Center 1700